

REMARKS

Claims 1-46 are pending in the application and claims 47-64 were previously cancelled in a preliminary amendment filed with the application. Claims 1-46 all stand rejected by the September 17, 2004 Office action ("the Office Action"). Entry of the foregoing amendments and allowance of amended claims is respectfully requested, as explained in detail herein.

ORDER OF INVENTORS' NAMES

The Applicants note that Inventor Flynn is improperly listed as the first named inventor, rather than inventor Baasch. As such, the Applicants respectfully request reordering the inventor names to be in the proper order (Baasch, Flynn, Rucker, Wilson).

AMENDMENTS TO THE CLAIMS

Claims 1-29 have been cancelled without prejudice to pursue the subject matter in continuing or related applications. Claim 30 has been amended to incorporate the recitations of claim 40, and claim 40 has been cancelled.

OBJECTIONS TO THE CLAIMS

The Examiner objected to claims 1, 10, 30 and 40 for various alleged informalities.

With regard to claim 30, the Examiner suggested that "a nozzle for providing nitrous oxide" should read -- a nitrous oxide nozzle for providing nitrous oxide --. In the foregoing amendments, the Applicants have adopted this suggestion in part, but have replaced the "for providing" language with -- adapted to provide --, to be consistent with the amendments to the remaining claims, as discussed immediately below. This amendment does not change the scope or meaning of these claims, and is not made in response to rejections based on prior art or the statutory conditions of patentability.

Regarding claims 30 and 40, the Examiner suggested amending each instance of "for providing" to read -- providing --, and each instance of "for passing" to read

“passing.” The basis for the objection is not entirely clear to the Applicants. Furthermore, this suggested amendment might be misunderstood to convert the *apparatus* claims into *method* claims because the scope of the claims would be limited such that they would only literally encompass a nitrous oxide nozzle during the time that is actually performing the “providing” or “passing” functions. As will be appreciated by the Examiner, method claims are only literally infringed by those performing the recited steps, and therefore, under the suggested language, only the *users* of an infringing device would be liable for literal infringement, and not the makers or sellers of such a device.¹ The Applicants see no reason for amending the claims in such a way that would limit their ability to pursue makers and sellers of the invention for literal infringement, as may result from the Examiner’s suggested amendment. Therefore, rather than adopting the suggested changes, the Applicants have amended each instance of “for providing” to read -- adapted to provide --, and each instance of “for passing” to read -- adapted to pass --. This change is believed to more clearly indicate that the invention is structurally adapted to perform the recited functions, without incorporating method-like step requirements into the claims. These amendments do not change the scope or meaning of these claims, and are not made in response to rejections based on prior art or the statutory conditions of patentability.

Entry of these amendments and withdrawal of the objections is respectfully requested. If the Examiner still feels that these claims are objectionable, the Applicants request that the Examiner provide comments identifying the exact reason for the objection so that the Applicants can fully address the Examiner’s concerns.

¹ Of course, makers and sellers of the product would be liable for contributory infringement and/or inducing infringement.

CLAIM REJECTIONS***Double Patenting***

The Examiner provisionally rejected claims 1, 10, 15-30, 37-40 and 44-46 as allegedly not being patentably distinct from claims 15-29 and 47-64 of co-pending U.S. Pat. No. 10/286,843. A terminal disclaimer is filed herewith to overcome this rejection. As such, reconsideration and allowance of the rejected claims is respectfully requested.

Rejections under 35 U.S.C. §§ 102 and 103

The Examiner rejected claims 1-4 and 30 under 35 U.S.C. § 102 as allegedly being anticipated by either of Kadowaki (U.S. Pat. No. 5,211,682) or Hoffer (U.S. Pat. No. 5,255,658). The Examiner further rejected claims 5-8, 11-14, 31-36 and 41-43 under 35 U.S.C. § 103 as allegedly being obvious in view of Application No. 10/286,843 or Kadowaki or Hoffer. The Applicants respectfully note that Application No. 10/296,843 is not believed to be applicable as prior art against this application, which is a continuation of Application No. 10/296,843, and names all of the same inventors.

The Applicants note that the Office Action does not provide any statutory basis for rejecting remaining claims 37-40 and 44-46.² These claims are therefore presumed to be considered allowable but for the double patenting rejection. As such, the Applicants have amended claim 30 to include the recitations of allowable dependent claim 40, and have amended those claims depending from claim 40 to depend from claim 30. These amendments, in addition to the terminal disclaimer filed herewith, are believed to place amended claim 30 and all claims depending therefrom in allowable condition.


² Applicants also note that the rejections of claims 41-43 appear to be in error because these claims depend from presumably allowable claim 40. However, the amendments provided herein render this issue moot.

CONCLUSION

Applicants believe that the remaining claims are in condition for allowance, and notification thereof is respectfully requested. If the Examiner believes that prosecution of the application can be expedited by further discussions with the Applicants' representative, the Examiner is invited to telephone the Applicants' representative at the direct dial number provided below.

Respectfully submitted,
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